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## FACSIMILE COVER PAGE

**DATE:** August 3, 2005  
**TO:** Patrick Ryan  
**FAX NUMBER:** (571) 273-8300  
**RE:** Serial No. 09/930,539  
Docket: 7310.C

**TOTAL NUMBER OF PAGES INCLUDING COVER SHEET:** 10

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Thank you.

When it became clear to Director Ryan, for the first time, that parent application Serial No. 09/037,801 and a CPA thereof had been rejected three times, among other rejections in other applications, Director Ryan apologized, indicated he had earlier misunderstood the situation and took personal responsibility for the failure to deal with the four appeals in question.

During the interview, Applicants pointed out that in Serial No. 10/317,539 an appeal was mailed December 15, 2004 and an Appeal Brief mailed December 16, 2004. No Examiner's Answer has been filed between December 16, 2004 and the July 11, 2005 interview nor has any other communication been dispatched by the Examiner. Director Ryan indicated he would review promptly the 10/317,539 file and, if appropriate, would have the Examiner prepare, serve and file his Answer.

As to Serial No. 10/350,474, Applicants made clear in the interview that two appeals are pending. Claims from grandparent Serial No. 09/037,081 were moved to parent Serial No. 09/627,959 and thence to Serial No. 10/350,474, where after over six years of pendency, a first appeal was filed on April 28, 2003 as to all of the claims previously rejected and moved forward to Serial No. 10/350,474. The Examiner, in over two years, has yet to file his Answer.

Instead, in Serial No. 10/350,474, the Examiner issued a restriction of claims previously examined as a single invention in Serial No. 09/627,959. This violated the results of a Petition which set to one side, the Examiner's twenty-three way restriction in Serial No. 09/037,081, which, by "agreement" with the Examiner and his supervisor, limited the restriction to a five-way restriction.

Thereafter, the Examiner once more rejected the improperly restricted and elected claims of Serial No. 10/350,474. The claims were somewhat amended and a second Notice of Appeal was filed. The Examiner has refused to file an Answer to the second appeal, the Examiner erroneously

contending that no appeal can be taken from claims having amendments therein no matter how many times they have been rejected.

The Examiner erroneously protested that a small footprint or area limitation had not been searched, when, in fact, the Examiner allowed U.S. Patent 6,610,440 (Serial No. 09/627,959), which contains the following claim:

1. A microfabricated battery comprising a pair of microscopic electrodes, a microscopic amount of electrolyte disposed in a microscopic site between the electrodes, the microfabricated battery *comprising an area as small as one square micron.*

Clearly, the Examiner has searched a small footprint or area and found that feature to be new, useful and non-obvious in the context of a microfabricated battery.

While the Examiner protested, exhibiting apparent bias, that he needed to do a further search to find small footprint prior art, the Applicants urged that the two appeals were both timely and proper and Examiner's Answers were long overdue in Serial No. 10/350,474.

In Serial No. 09/930,539, as is evident from Attachment "A," thrice rejected claims from parent Serial No. 09/037,081 were placed in Serial No. 09/930,539 and, after three years, once more rejected. The Notice of Appeal was timely filed on November 19, 2004 and the Brief on December 2, 2004. No Examiner's Answer has been filed, the Examiner insisting that a fifth rejection is required before an appeal is timely.

The Applicants urged the Director to cause Examiner's Answers to be filed as soon as possible to all four appeals in the three above-identified applications, based on *Ex parte Lemoine*, 46 USPQ 2d 1420 (Bd. of Pat. App. and Interf. 1998), which held:

Section 134 of Title 35 gives applicants the statutory right to an administrative appeal. The section provides:

An applicant for a patent, any of whose claims have been twice rejected, may appeal from the decision of

the primary examiner to the Board of Patent Appeals  
and Interferences . . . .

Jurisdiction for this appeal depends on whether appellant is an applicant "any of whose claims has been twice rejected." We conclude that appellant had the right to appeal the rejections and we have jurisdiction.

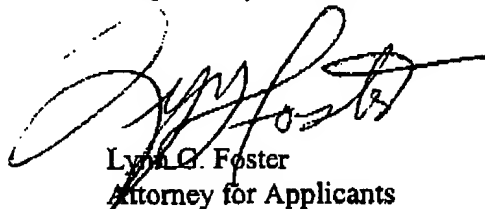
To reach a decision requires us to construe the word "claims" as used in § 34 [sic, § 134]. The word is susceptible to at least two interpretations. It can refer to the claims of an application, *i.e.*, the "one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention required by 35 U.S.C. § 112, ¶ 2. Or the word can be used in a more general sense to refer to claims "for a patent" as it is used in 35 U.S.C. § 132. In this latter sense, the word is synonymous with a request or demand for a patent.

\* \* \* \*

. . . we conclude that the "claims" as used in § 134 is a reference to the repeated "claim for a patent" as used in § 132 rather than a reference to a particular claim "of an application." Under our interpretation, *so long as the applicant has twice been denied a patent, an appeal may be filed.* So construing the statute, we conclude that applicant's claims for a patent have been twice rejected. Applicant has been denied a patent three times. Applicant, therefore had the right to appeal and we, accordingly, have jurisdiction. (Emphasis added).

The Director indicated he would confer with the editor of the MPEP and report quickly to the undersigned.

Respectfully submitted,



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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

RODNEY M. LAFOLLETTE, ET AL.

Serial No.: 09/930,539

Filed: August 14, 2001

For: MICROSCOPIC BATTERIES FOR  
MEMS SYSTEMS

Docket: 7310.C

Art Unit: 1745

Director: Patrick Ryan

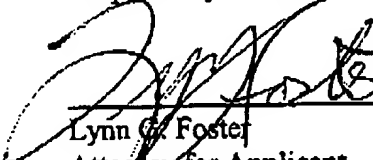
Examiner: RAYMOND ALEJANDRO

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AUG 03 2005CERTIFICATION OF FILING BY FACSIMILE TRANSMISSIONPatrick Ryan  
Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I hereby certify the attached APPLICANTS' SUMMARY OF INTERVIEW was transmitted  
by facsimile to the above-identified Examiner at (571) 273-8300 on the date indicated below.

Respectfully submitted,

  
Lynn G. Foster  
Attorney for Applicant

August 3, 2005

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